

## REMARKS/ARGUMENTS

Responsive to the Office Action mailed January 25, 2008:

### I. NON-PRIOR ART MATTERS

- A. The Office Action rejected claim 13 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

The Office Action states:

Regarding claim 13, it does not make sense that the abbreviation can be inserted at any position in the existing text in the limitation “inserting the abbreviation into the pre-existing text at a position selected by the user at any position in the existing text.” The insertion of abbreviation can be carried out *only at the position of a word having a corresponding abbreviation*. At other positions of other words that do not have corresponding abbreviations, such insertion appears improper.

With all due respect, the Examiner has no authority arbitrarily to limit Applicant's claims as long as the claim is supported by the original disclosure. Claim 13 as originally filed (which is part of the Specification) did not limit such insertion to only at the position of a word having a corresponding abbreviation.

In patent claim construction, the indefinite article “a” is construed to mean “one or more.”:

A general rule is that an indefinite article “a” or “an” in a patent claim means “one or more,” not “only one,” unless the claim is “specific as to the number of elements” or the context of the claim “suggests ambiguity” in the meaning of the indefinite article.<sup>1</sup>

Therefore, the language “at a position” should be interpreted as “at one or more positions.”

The Office Action states:

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<sup>1</sup> *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 55 USPQ2d 1835 (Fed. Cir. 2000).

Therefore, claiming that inserting is carried out "at any position in the existing text" includes inserting at the positions of the words that do not have corresponding abbreviations also. This is opposite to the disclosure of the application where the insertion occurs only at specific positions – the positions of the words having corresponding abbreviation.

There is nothing in the disclosure that is "opposite" to the claimed limitation. Step 200, at page 7 of the original disclosure, does not limit operation to insertion of abbreviations at the position of words having the corresponding abbreviations. Furthermore, the flowchart (Fig. 1, Fig. 2a) also has no such limitation.

The rejection is therefore respectfully traversed.

- B. The Office Action rejected claim 14 under 35 U.S.C. 112 second paragraph, as being indefinite for failing to particularly point out an distinctly claim the subject matter which applicant regards as the invention.

Claim 14 is cancelled herein.

## II. PRIOR ART MATTERS

A. The Office Action rejected claims 1-22 under 35 USC 103(a) as being unpatentable over Ichbiah in view of Goldwasser and further in view of Shaw.

The 103 rejection is based on the standard of disclosure of 35 USC 102 as to each reference (MPEP 2141.01):

"Before answering *Graham's* 'content' inquiry, it must be known whether a patent or publication is in the prior art under 35 U.S.C. § 102." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593, 1597 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Subject matter that is prior art under 35 U.S.C. 102 can be used to support a rejection under section 103. *Ex parte Andresen*, 212 USPQ 100, 102 (Bd. Pat. App. & Inter. 1981) ("it appears to us that the commentator [of 35 U.S.C.A.] and the [congressional] committee viewed section 103 as including all of the various bars to a patent as set forth in section 102.").

A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claims under 35 U.S.C. 102(b). Analogously, an obviousness rejection based on a publication which would be applied

under 102(a) if it anticipated the claims can be overcome by swearing behind the publication date of the reference by filing an affidavit or declaration under 37 CFR 1.131.

“For a prior art reference to anticipate...every element of the claimed invention must be identically shown in a single reference...These elements must be arranged as in the claim under review.”<sup>2</sup> “This standard is very strict. It requires an exact correspondence between the contents of the event and the claim limitations, such that each and every element recited in the claim is present in the anticipatory event.”<sup>3</sup>

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.<sup>4</sup> If the Examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.<sup>5</sup>

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.<sup>6</sup>

Applicant respectfully traverses the § 103 rejection because the office action has not established a *prima facie* case of obviousness.

**1. The cited prior art does not teach or suggest all the claim limitations.**

Claim 1

As to claim 1, Shaw (Find and Replace) does not disclose:

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<sup>2</sup> *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)

<sup>3</sup> *Moy's Walker on Patents*, 4<sup>th</sup> ed., § 8.11 (citing *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q.2D(BNA) 1655 (Fed. Cir. 1990))

<sup>4</sup> MPEP Sec. 2142.

<sup>5</sup> *Id.*

<sup>6</sup> *Id.* (emphasis supplied)

actively selecting a word in the pre-existing text to be converted to an abbreviation, displaying a list of suggested abbreviations corresponding to the selected word and receiving input from the user to choose the desired abbreviation, converting the selected word to a corresponding abbreviation using the first data structure, and replacing the word with the corresponding abbreviation...

actively selecting an abbreviation in the pre-existing text to be converted to a word, displaying a list of suggested words corresponding to the selected abbreviation and receiving input from the user to choose the desired word, converting the selected abbreviation to a corresponding word using the second data structure, and replacing the abbreviation with the corresponding word.

The Office Action states:

Applicants argue that the text in Ichbiah and Goldwasser is not a pre-existing text, and so replacing a selected abbreviation with a corresponding word and replacing a selected word with a corresponding abbreviation are not performed in a pre-existing text. Examiner agrees. Shaw discloses the argued feature.

Shaw (pp. 171-172) does not provide a list of suggested abbreviations corresponding to the selected word and receiving input from the user to choose the selected abbreviation. Rather, Shaw requires the operator to enter an abbreviation at the **Replace With** box. Furthermore, using Shaw's Find and Replace also does not disclose providing a list of words corresponding to the selected abbreviation and receiving input from the user to choose the selected word.

Shaw's Autotext also does not provide the claimed limitations. Shaw (p. 213) requires the user to type the name assigned to the AutoText entry. There is no disclosure that Shaw allows the user choice of abbreviations or words to insert. Rather, the single entry corresponding to the entered name assigned to the AutoText entry is inserted.

Claim 1 is therefore allowable.

Claims 2-6 are contain additional elements or limitations beyond allowable claim 1 and are also allowable.

Claims 7-14 are cancelled herein.

### Claim 15

Claim 15 is allowable for the reasons given above in regard to claim 1.

Claim 16 contains additional elements or limitations beyond allowable claim 15 and is also allowable.

### Claim 17

Amended claim 17 is allowable for the reasons given above in regard to claim 1.

Claims 18-22 are cancelled.

### Claims 23-24

New claims 23 and 24 are also allowable for the reasons given above in regard to claim 1. These claims do not introduce new matter.

2. The Examiner has not applied the test of *Graham v. John Deere Co.*<sup>7</sup> The MPEP requires the Examiner to do so.<sup>8</sup> However, the Examiner has made no finding of the level of ordinary skill in the art.<sup>9</sup>

The Federal Circuit routinely vacates conclusions of obviousness when the factfinder failed to make *Graham* factor findings.<sup>10</sup> This is especially so when the factfinder makes conclusory statements that “do not fulfill the agency’s obligation’ to explain all material facts relating to a motivation to combine.”<sup>11</sup>

For the above reasons, Applicant respectfully requests the allowance of all claims and the issuance of a Notice of Allowance.

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<sup>7</sup> 383 U.S. 1 (1966)

<sup>8</sup> MPEP § 2141

<sup>9</sup> MPEP § 2141.03


<sup>10</sup> *Dystar*, 464 F.3d 1366 and cases cited therein.

<sup>11</sup> *Id.*

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 02-3732.

Respectfully submitted,

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